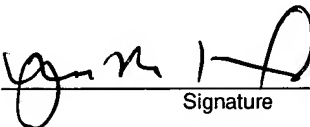




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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 0114089.00120US2	
	Application Number 10/720821-Conf. #5355	Filed November 24, 2003	
	First Named Inventor Douglas B. WILSON		
	Art Unit 3682	Examiner V. Luong	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div><input type="checkbox"/> applicant /inventor.</div> <div><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div> <div><input type="checkbox"/> attorney or agent of record. Registration number _____</div> <div><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>30,271</u></div> <div> Signature <u>Wayne M. Kennard</u> Typed or printed name <u>(617) 526-6000</u> Telephone number <u>May 31, 2006</u> Date</div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <div><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>			

Express Mail Label No. EV804261480US Dated: May 31, 2006



Pre-Appeal Request

I. Introduction

This pre-appeal request is submitted in response to the Final Office Action dated May 9, 2006.

Claims 20-28 are pending in the present application. Of these claims, claim 20 is the only independent claim. The Examiner of Record has rejected pending claims 20-28 for anticipation under 35 U.S.C. § 102 based separately on either Van Arsdel, U.S. Patent No. 2,118,540; Anson, U.S. Patent No. 2,134,020; or Laubach, U.S. Patent No. 1,575,848. More specifically, the Examiner rejected claims 20-26, and 28/20 relying on either Van Arsdel or Anson, and claims 20, 27, and 28/27 on Laubach. Since the Examiner has rejected the only independent claim, claim 20, separately on Van Arsdel, Anson, or Laubach, if Applicant demonstrates that neither of these references establishes a prima facie basis of anticipation, then dependent claims 21-28 that depend from claim 20 also will not be anticipated by the three references.

In order for there to be anticipation under 35 U.S.C. § 102, a single prior art reference must show each and every feature of the claimed invention in the same way. *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (“To anticipate, every limitation of the claimed invention must be found in a single prior art reference, arranged as in a claim”); *Kloster Speedsteel AB v. Crucible, Inc.*, 794 F.2d 1565, 1571 (Fed. Cir. 1986) (“absent from the reference of any claimed element negates anticipation”). Applicant submits that neither Van Arsdel, Anson, nor Laubach satisfy the standard for finding anticipation under 35 U.S.C. § 102.

II. Van Arsdel Does Not Anticipate Claims 20-26 and 28/20

In order to demonstrate that Van Arsdel includes each of the elements of claim 20, the Examiner principally relies on the reference's Figures and annotated versions of Figures 3 and 5.¹ In his rejection, the Examiner states that reference no. 4 equates to the first section and reference no. 2 equates to the second section of claim 20. Applicant submits that the Examiner fails to consider and appreciate all of the elements of the second section because if he did, two things would be clear: (i) the grip-rest is in a plane parallel with the one across the face of the steering wheel and (ii) there is a missing element. Therefore, Van Arsdel does not establish a

¹ The annotated versions of Figures 3 and 5 are Attachment 1 to the Office Action dated May 9, 2006.

prima facie basis of anticipation, even considering the “broadest reasonable interpretation” standard recited by the Examiner.

The missing element is underlined in the following quotation:

The second section extends from the first section outward at an angle to a plane across the face of the steering wheel, the second section for supporting at least a portion of a vehicular operator’s body when pressure from the portion of the vehicular operator’s body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator’s ability to operate the steering wheel, and deforming out of interference with the vehicular operator’s ability to operate the steering wheel when pressure from the portion of the vehicular operator’s body on the second section is equal to or greater than the pressure for performing the second section out of interference with the vehicular operator’s ability to operate the steering wheel. [Emphasis added.]

The Examiner’s citation to Van Arsdel to support his contention that it teaches each of the elements of the second section is the following:²

The rotation of the steering wheel by hand pressure against the flanges 4 and 5 is assisted by the palm and fingers which are wrapped around the rim of the wheel, and to increase the finger hold the grip-rest 2, which is thickened and bifurcated to straddle the rim as shown in Fig. 6, is provided with recesses separated by ridges here shown as three in number, 6, 7, and 8....

The weight of the hand and arm are comfortably supported with the bottom of the hand resting in the concavity of the grip-rest as shown in Fig. 1, or with the ball of the thumb seated in the concavity as shown in Fig. 2....

My improved grip-rest may be formed integral with the rim of the steering wheel as shown in Fig. 8, but I prefer to make it removable as an attachment for any make of car and also to make it adjustable to suit the requirements or fancy of the driver.

Van Arsdel, Page 1, Right Column, Lines 29-54.

The Examiner contends that the grip-rest is deformable; however Applicant submits this is not supported by Van Arsdel. Van Arsdel requires the following to move the grip-rest: loosen the screw, reposition the grip-rest, and retighten the screw.³ Applicant submits that this is not deforming according to claim 20 during normal use of the grip-rest. Once the grip-rest of Van Arsdel is in place, it is fixed, does not move. Thus, Van Arsdel is missing the deforming element.

Applicant’s position is supported by Van Arsdel:

The grip-rest 2 is concave longitudinally and about half of the rest extends over and part way across a steering wheel rim 3 in a manner to slope downwardly and inwardly of the rim. The outer edge 4 on the side, and 5 on the rear end of the concave, located

² See Office Action dated May 9, 2006, p. 3.

³ See Van Arsdel, Page 2, Left Column, Lines 28-32.

above the rim, extends up into a marginal flange to be contacted by the inside of the ball of the thumb by the bottom of the hand, depending upon which part of the hand is seated on the rest. These flanges 4 and 5 enable the operator instantly to feel any deviation of the car from a straight course and gives him something substantial to push against in resistance and also in rotating the wheel to steer the car around corners and curves and away from a obstructions or bad places in the roadway. [Emphasis added.]

Van Arsdel, Page 1, Right Column, Lines 13-28.

The quotation immediately above clearly demonstrates that the grip-rest of Van Arsdel does not deform according to claim 20 when pressure is applied to it. Noting this, Van Arsdel is missing at least one element and, as such, it cannot establish a prima facie basis of anticipation.

II. Anson Does Not Anticipate Claims 20-26 and 28/20

The Examiner rejected claims 20-26 and 28/20 as anticipated by Anson. The Examiner relying on annotated Figures 1, 2, and 8 stated reference no. 13 equates to the first section and reference no. 11 equates to the second section of claim 20.⁴ However, it is important to review the description of Anson's attachment:

I have found that in the driving of an automobile and particular when driving for extended periods of time over long distances, the normal manner of holding and manipulating the steering wheel, wherein both driver's hands grasp the wheel and positions which require the driver's arms remain in a raised and more or less unnatural and uncomfortable position, considerable strain develops in the driver's hands, arms, shoulders and back particularly, and results in excess of fatigue...

To obviate these disadvantages, I have devised an attachment for steering wheels, which permits a driver to assume a completely comfortable and relaxed driving position, while at the same time, affords a means permitting the driver to at all times retain positive operating control of the steering wheel. [Emphasis added]

Anson, Page 1, Left Column, Lines 6-25.

The steering wheel attachment of Anson is described as follows:

The attachment comprises a hand grip portion 11, which is preferably of bulbular form Grip portion 11 normally extends downward from the wheel rim and is of suitable length to adapt same to extend to the region of the driver's lap so that it may be grasped by the driver's hand when his hand is resting in a normal comparable position in his lap. Grip portion 11 is reduced in cross-sectional area at one end to form a neck 12. Neck 12...will have sufficient pliability...to be deflected from its normal pendant position without adversely affecting the measure of control of the steering wheel movements afforded by the positive operating movement of the attachment, while at the same time, neck 12 will retain sufficient rigidity to permit operating movements of hand grip 11 to be positively communicated to the steering wheel rim for effective control of its movements. [Emphasis added]

⁴ See Office Action dated May 9, 2006, p. 4.

Anson, Page 1, Right Column, Line 49 – Page 2, Left Column, Line 18.

The Examiner has cited Anson at Page 2, Left Column, Lines 62-72, as teaching the deformability element of the second section in claim 20. As the quotation above demonstrates, when the Anson handgrip is in use, it is in the pendent position and used to steer the vehicle. If, during normal operations, the driver were to grab the steering wheel in an emergency situation, he would release the handgrip and grab the wheel, for example, at the 10 and 2 o'clock positions. In doing so, the pendent-hanging handgrip would not be deformed as set forth in claim 20 because it would not be in use. Moreover, if it were used, it would not be deformed out of interference but would be held to steer the vehicle.

The Examiner has stated the handgrip of Anson equates to deformation according to claim 20 because it may be moved from the bottom pendent position to the top of the steering wheel. When the handgrip is moved to the top, it is moved there to be purposefully out of use all the time so it will not be in a position to be deformed as set forth in the second section of claim 20.⁵ In order to move the handgrip, it would be understood that the vehicle would have to be stopped, the handgrip detached and repositioned at the top, and reattached. Noting this, Anson is missing at least the deforming element of claim 20 and, as such, it does not support a prima facie basis of anticipation.

III. Laubach Does Not Anticipate Claims 20, 27 and 28/27

The Examiner rejected 20, 27, and 28/27 for anticipation based on Laubach. The Examiner relying on annotated Figure 2 has indicated that reference nos. 7 and 8 equates to the first section and reference no. 10 equates to the second section of claim 20.⁶ Applicant submits that Laubach does not form a prima facie basis of anticipation because at least one element is missing.

Laubach states the following with regard to the knobs attached to the steering wheel:

By particularly considering the Figures 2 and 3, it will be seen that the knobs 2 are secured to the rim of the wheel 1 by means of securing screws 4, these screws being threaded as indicated at 5 longitudinally through the knob 2, and extending for quite a distance through the entire length of the knobs, thereby efficiently bracing the same. The inner ends of the knobs 2 are concave as indicated at 6, so as to conform to the contour of the outer periphery of the wheel 1...

⁵ Anson, page 2, left column, lines 68-72.

⁶ See Office Action dated May 9, 2006, pp. 5-6.

Each knob 2 is provided with a plurality of finger sockets 9 upon the upper face thereof, and an enlarged head portion 10 at the outer end thereof, for the purpose of facilitating the gripping of the knob and preventing the actual slippage of the hand of the operator from the knob 2. [Emphasis added]

Laubach, Page 1, line 43 – 71.

The description of the knobs and a review of the Figures makes plain that the knobs are not deformable and they are not disposed at an angle with respect to the a plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as in the second section of claim 20. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Therefore, Laubach does not support a prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs.

IV. Conclusion

Applicant has demonstrated that each of the references relied on by the Examiner, namely Van Arsdell, Anson, and Laubach, is missing at least one element of claim 20, the only independent claim in the present application. As such, neither of these prior art references can form a prima facie basis for anticipation for claim 20 or claims 21-28 that depend from it.

The foregoing supports Applicant's position that the Examiner's anticipation rejections should be reversed and the application passed to issue.